

REMARKS

In view of the following remarks, the Office is respectfully requested to allow claims 11, 13-15, 27, 31, 39-44, the only claims pending and under examination in this application.

Claims 41 and 42 have been amended to clarify the wording of the claims. These amendments do not change the scope of the claims and have been made solely to place the claims in condition for allowance. Entry thereof by the Examiner is therefore respectfully requested.

Claim Rejections – 35 U.S.C. § 102

Claim 42 was rejected under 35 U.S.C. § 112, second paragraph. In view of the above amendment to Claim 42, this rejection may be withdrawn.

Claim Rejections – 35 U.S.C. § 102

Claims 11, 13-15, 27, 31, and 39-44 have been rejected under 35 U.S.C. § 102(e) as allegedly anticipated by Fogarty et al. (U.S. Patent No. 6,291,243).

An element of the pending claims is "a pair of P-element transposase recognized insertion sequences flanking a heterologous promoter and a single transcriptionally active gene that comprises said exogenous nucleic acid"

In identifying this element in the '243 patent, the Examiner asserts that the '243 patent anticipates this claim element by referring to col. 5, lines 5-9 of the '243 Patent, which states:

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vectors that include a single transcriptionally active gene. In vectors of this embodiment of the subject invention, the promoter that is part of the transcriptionally active gene may be any of those described above, e.g. SV40, with the proviso that the promoter is not a CMV promoter. Vectors of this embodiment that include a single transcriptionally active gene may be prepared and used as described below, where the following description is provided in terms of vectors that include at least two transcriptionally active genes.

Methods of Preparing the Subject Vectors

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The enclosed declaration filed in copending application Serial No. 10/659,802 indicates that to the extent that this particular claim element is disclosed (if at all) in the specification of the '243 Patent, this particular claim element was not conceived of by Joseph Lipsick, but rather by Patrick Fogarty.

As such, the '243 Patent represents the Applicants' own work and does not qualify as work "by another" under 35 U.S.C. §102(e).¹

Accordingly, the '243 Patent is not available as prior art and withdrawal of the rejection under 35 U.S.C. § 102(e) is appropriate and respectfully requested.

To the extent the Examiner's rejection is based on a reference to the pCasper4 vector in Figure 2, it is noted that the '243 patent never teaches introduction of the pCasper4 alone into a host. pCasper4 is used to make the gene transfer vector but is not introduced by itself into a host.

Accordingly, withdrawal of the rejection under 35 U.S.C. § 102(e) is appropriate and respectfully requested.

1 Under M.P.E.P. §715.01(c), §716.10 and §2136.05, when the applicant is the inventor of the subject matter disclosed in a patent or published application cited against his or her application, he or she may overcome the rejection by filing a declaration to establish that the patent or published application describes the applicant's own work. Such a declaration by the applicant is sufficient to remove the patent or published application as a reference under 35 U.S.C §102(a) and (e) (*In re Katz*, 687 F.2d 450, 455, 215 USPQ 14, 18 (CCPA 1982) and *In re Matthews*, 408 F.2d 1393, 161 USPQ 276 (CCPA 1969)).

STATEMENT UNDER 37 C.F.R. §§1.56 AND 1.2

Applicants hereby advise the Examiner of the status of a co-pending application in compliance with the Applicant's duty to disclose under 37 C.F.R. §§1.56 and 1.2 (see also MPEP §2001.06(b)) as discussed in *McKesson Info. Soln. Inc., v. Bridge Medical Inc.*, 487 F.3d 897; 82 USPQ2d 1865 (Fed. Cir. 2007).

The Applicants wish to bring to the Examiner's attention that a Final Office Action was mailed on April 1, 2009 in co-pending U.S. Patent Application No. 10/659,802, filed February 16, 2006.

These documents are available on PAIR, and thus are not provided with this communication.

CONCLUSION

Applicants submit that all of the claims are in condition for allowance, which action is requested. If the Office finds that a telephone conference would expedite the prosecution of this application, please telephone the undersigned at the number provided.

The Commissioner is hereby authorized to charge any underpayment of fees associated with this communication, including any necessary fees for extensions of time, or credit any overpayment to Deposit Account No. 50-0815, order number TOSK-007CIPCON.

Respectfully submitted,
BOZICEVIC, FIELD & FRANCIS LLP

Date: April 7, 2009 By: /Bret E. Field, Reg. no. 37,620/
Bret E. Field
Registration No. 37,620

enc: Declaration by Dr. Patrick Fogarty

BOZICEVIC, FIELD & FRANCIS LLP
1900 University Avenue, Suite 200
East Palo Alto, California 94303
Telephone: (650) 327-3400
Facsimile: (650) 327-3231